

**Remarks**

In a January 22, 2004 office action, the Examiner rejected Claims 1-15, 20, and 21. Of these, Claims 2, 3, 20, and 21 have been cancelled so that Claims 1 and 4-15 remain pending. Claims 1, 4, 5, 7, and 12 have been amended. The amendments to Claims 1, 7, and 12 find support in the Specification on Page 6, line 28 through page 7, line 8. Claims 4 and 5 have been amended so that they now depend from Claims 1. Consequently, no new matter has been added.

***Rejections Under 35 U.S.C. § 103***

The Examiner rejected Claims 1 and 4-15 under Section 103 citing USPN 6,012,890 issued to Celorio Garrido in light of USPN 4,589,376 issued to Burton alone or in further view of an October 1987 article in PC Magazine (10/1987) or a March 1998 article from the New Statesman (3/1998). To establish a prima facie case of obviousness, the Examiner must show some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; that there is a reasonable expectation of success; and that the prior art reference (or references when combined) teach or suggest all the claim limitations. MPEP § 2142.

Claims 1 and 4-6 are directed to a book manufacturing method with each of Claims 4-6 depending from Claim 1. Garrido, Burton, and the two articles cited by the Examiner fail to teach one or more limitations required by each of Claims 1 and 4-6.

Claim 1 is directed to a book manufacturing method. As amended, Claim 1 requires the following limitations:

- a) identifying a set of books;
- b) receiving a dimension of a book storage space;
- c) selecting format criteria and page and cover media according to the received dimension and the identified set of books, the format criteria

defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space; and

- d) manufacturing the set of books according to the selected format criteria and using the selected page and cover media.

Garrido discusses producing books in four sizes – those sizes being dictated by the sizes of commercially available sheets of paper. Col. 7, lines 29-46. The user selects the paper size, and the user selects size and type fonts to be used. Col. 7, lines 23-28 and 47-49. Garrido places no restriction on the font size of paper size the user can select. In stark contrast, Claim 1 requires that a set of books be produced to fit in a book storage space – the production of the books being guided by a dimension of that storage space and the particular set of identified books. To that end, Claim 1 requires the selection of format criteria and page and cover media according to the received dimension and the identified set of books so that when produced, the set of books will fit in the book storage space. This requirement is not taught by Garrido.

Burton teaches a custom manufacturing process where a customer's measurements are taken and transmitted to a computer where an order is generated. The order is transmitted to a remote location for manufacture. An article of clothing is then manufactured according to the customer's measurements. Burton, Abstract. In short, Burton teaches receiving a measurement of a customer (not a book storage space) and tailoring a garment according to that measurement. Claim 1, on the other hand, requires identifying a set of books, receiving a dimension of a book's storage space, and selecting format criteria and page and cover media according to the identified books and the received dimension none of which is taught by Burton.

The 3/1998 article describes a book sized to fit in a pocket, a knapsack, or a cabin bookshelf. The 10/1987 article discusses a reference book for a computer program. That book "fit on any bookshelf." Granted, bookshelves are designed to hold books. However, Claim 1 requires that a set of books be

manufactured in such a manner that the set of books fits in a pre-defined book storage space.

Consequently, Garrido, Burton, and the cited articles fail, alone or in combination, to teach a book manufacturing method requiring that media and format criteria be selected according to an identified set of books and a given dimension of a book storage space. Moreover, those references fail to teach that the selections be made so that the set of books, once manufactured, fits within the book storage space. For these reasons, Claim 1 is felt to distinguish over the cited art.

Claims 4-6 each depend from Claim 1 and include all the limitations of that base claim. For the same reasons Claim 1 distinguishes over the cited art, so do Claims 4-6.

Claims 7-11 are directed to a book on demand manufacturing system with each of Claims 8-11 depending from Claim 7. Claim 7, as amended, requires the following limitations:

- a) an order placement system capable of receiving input identifying a set of books and a dimension of a book storage space and of selecting page and cover media as well as format criteria according to the received dimension and the identified set of books, the format criteria defining at least a font size, the selections being made so that the set of books, once manufactured, will fit within the book storage space;
- b) a print module operable to use selected page media and format criteria to print the pages of the set of books and to use selected cover media to print the covers of the set of books; and
- c) a finishing module operable to bind each printed cover and corresponding printed pages to produce a set of finished books.

In short, Claim 7 is directed to a system for performing the method steps of Claim 1. Rejecting Claim 7, the Examiner stated "it would have been obvious to

a skilled artisan to set up a system ... to carry out the method steps as shown on claim 1."


As noted above, Garrido, Burton, and the cited articles fail to teach one or more limitations required by Claim 1. Consequently, the cited references do not teach all the limitations required by Claim 7. For these reasons, Claim 7 and Claims 8-11, which depend from Claim 7, are felt to distinguish over the cited art.

Claims 12-15 are directed to a computer readable medium having instructions relating to the manufacture of a set of books. Claims 13-15 depend from Claim 12. Claim 12 requires instructions for performing the method steps of Claim 1. For the same reason Claim 1 distinguishes over the cited art, so do Claims 12-15.

**Conclusion**

In view of the foregoing remarks and amendments, the Applicant respectfully submits that claims 1 and 4-15 define allowable subject matter. The Examiner is requested to indicate the allowability of all claims in the application and to pass the application to issue.

Respectfully submitted,  
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April 16, 2004